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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,516	12/30/1998	DENNIS M. O'CONNOR	INTL-0134-US	1486

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EXAMINER

NGUYEN, HUY THANH

ART UNIT PAPER NUMBER

2615

16

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/223,516

**Applicant(s)**

O'CONNOR ET AL.

**Examiner**

HUY T NGUYEN

**Art Unit**

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-15 and 40-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 12-15 and 40-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 112***

2. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15, line 2, there is no antecedent basis for "said indication".

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 12-15, 40-42 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woo (5,485,219) in view of Vogel (4,097,893).

Regarding claims 40-41 and 12,14-15 ,42 and 44, Woo discloses a transmitter (Fig. 1) and a receiver, the transmitter comprising: a monitor that monitors an ongoing video transmission and provides an control signal comprises a start cue and a end cue (code command) associated with a portion of a broadcast program to a large number of receivers to recording the portion associated with the control signal, wherein said transmission device is an over the air broadcast television transmitter (Fig. 1, Abstract) or cable television transmitter transmission (column 3, lines 30-35, line 41 to column 4, line 15, column 5, line 27 to column 8, line 17, columns 10 and 11).

Woo fails to specifically teach that the recording command is transmitted together with video transmission. However, it is noted that transmitting a control signal inserted in the broadcast program to receiver to record a portion is well known in the art as taught by Vogel . Vogel at figure 3, teaches means for inserting command code (indicating signal), which separately received from a monitor , in a vertical interval of a video transmission to control a recorder to record a selected portion of a video transmission indicating by a start command (Fig. 3, column 5, lines 30-50). It would have been obvious to one of ordinary skill in the art to modify Woo with

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Vogel by using a inserting means as taught by Vogel for transmission the recording command along with the video transmission by inserting the recording command in a vertical blanking intervals that use for carrying closed captioned of the video transmission , as an alternative method for transmitting the recording command signal of Woo, for transmitting the recording command along with the video transmission.

Woo as modified Vogel fails to specifically teach monitoring a replay that is a video segment of a broadcast program. However, it is noted that transmitting a replay during a broadcast program of a video transmission is well known the art. Therefore official notice is taken and it would have bee obvious to one of ordinary skill in the at to modify Woo as modified with Vogel with by using the transmitter of Woo as modified with Vogel for receiving , monitoring a replay of the video transmission and generating the control signal , inserting the control signal in the broadcast program to receivers to record the replay when the user of receiver requested .

Regarding claim 13, Woo fails to specifically teach that the video transmission is from a satellite transmitter. However, it is noted that using a satellite transmitter for transmitting video signal is well known in the art . Therefore, official notice is taken and it would have been obvious to one of ordinary skill in the art to modify Woo by using a satellite transmitter for transmitting video transmission.

5. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woo (5,485,219) in view of Vogel (4,097,893) as applied to claims 41 above , further in view of Nagasaka et al (5,818,493).

Woo as modified with Vogel fails teach using information to determined a

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displaying format size of a replay .

Nakasaka teaches using information for video data to indicate a display size of video data on a monitor (column 6, lines 55-65).

It would have been obvious to one of ordinary skill in the art to modify Woo as modified with Vogel with the teaching of Nakasaka by providing the information for the size of the replay thereby enhancing the capacity of a monitor for preserving the remain area on the monitor for other display .

### ***Response to Arguments***

6. Applicant's arguments filed 08 March 2004 have been fully considered but they are not persuasive.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N

HUY T NGUYEN  
PRIMARY EXAMINER